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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/762,537	01/23/2004	Atsushi Tomita	1009683-000496	2578

21839 7590 02/14/2008

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EXAMINER

ART UNIT	PAPER NUMBER
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DATE MAILED: 02/14/2008

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/762,537	Applicant(s) TOMITA ET AL.	
	Examiner Victor R. Kostak	Art Unit 2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11, 14 and 15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11, 14 and 15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

1. Upon review of the prosecution history and in view of the current policies of the Office, the following rejection is presented involving 35 USC 101 regarding claims 14 and 15.

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 14 and 15 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 14 is introduced as a being a program (regardless of the subsequent associated subject matter recited therein). Section 2106.01 [R-6] I states that a computer program is functional descriptive material that is not statutory because it is not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permits the computer program's functionality to be realized. Claim 14 and dependent claim 15 are therefore rejected as being non-statutory.

3. Upon a review of the claim language, claims 1-9, 11, 14 and 15 are now objected to because of the following informalities: in independent claims 1, 5 and 11, applicant recites a second "*a control signal*" (line 12 in amended claim 1, line 21 of amended claim 5, and in line 14 of claim 11). The subsequently recited "*said control signal*" therefore has ambiguous antecedence. Based on the specification, the examiner has considered both recited control signals to be the same signal. Appropriate correction is required.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 5-8 and 11 are now rejected under 35 U.S.C. 102(b) as being anticipated by Suzuki (5,857,149).

The broadcast receiver of Suzuki (noting either embodiment shown in Fig. 2 or 7) includes a reception section 4 that receives broadcast video (television programming is disclosed: e.g. col. 4 line 66 – col. 5 line 5). Also broadcast is print-out data and a control signal (e.g. col. 9 lines 12-30). Extractor stage 7 detects the print-out data and control signal, and the print-out data is stored in memory M for eventual accessing by the control signal (noting again col. 9 lines 12-30 and continuing through lines 31-52). An output section includes a print unit 10 (misabeled "price" unit in the Figs.) that prints out the data stored in memory M so instructed by the control signal. The control signal is transmitted after the broadcast of the video data and print-out data is received (again col. 9 lines 12-15), thereby meeting claim 1.

As for claim 2, when the system (which includes the printer) is in the stand-by state, the user prompts the system by key input 16 (col. 9 lines 1-11).

As for claim 3, the second state can be the idle or standby state of the printer, which is different from the first (active or printing) state, the transition section being the extractor 7 associated with controller 8.

Regarding claim 5, the image forming apparatus includes associated elements 9-12 and memory M, and the first and second notification sections read on extractor 7 that provides detection of both the print-out data and the control signal.

As for claim 6, when the system is in the stand-by state (the system including the printer 10 and display 9 that forms imagery such as that in Figs. 3-5), the user prompts the system by key input 16 (col. 9 lines 1-11).

As for claim 7, the second state can be the idle or standby state of the printer, which is different from the first (active or printing) state, the transition section being the extractor 7 associated with controller 8.

As for claim 11, the transmitting section reads on controller 8 that transmits the signals from the output of stage 7 for further processing to the endpoint elements.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4 and 9 are now rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki in view of Johnson et al. (4,695,880 of record)

Reviewing Johnson, he also incorporates a printer with his television receiver (noting particularly Figs. 1-3), wherein receiver/decoder (noting Figs. 2 and 3) includes an image forming apparatus (the television display, not shown, or printer 50), wherein the cable subscriber's unit (corresponding to the claimed reception section) receives broadcasted signals

comprising print-out data (element 52) and control data for printing out the data (e.g. col. 5 lines 40-63). Microprocessor 60 detects the print-out data and the control data, RAM 48 can store the print-out data, and printer 50 in turn prints out the coupon based on the received control data.

It would have been obvious to one of ordinary skill in the art to use the controller of Suzuki the way Johnson uses his microcomputer 60: to detect the end of signal transmission, and to erase the data is from RAM 48 (col. 5 lines 48-56 and col. 10 lines 55-60), at least to not occupy memory capacity when the data is not useful anymore.

6. Claim 9 is now rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki.

Although Suzuki does not specify extracting second time data which relates the difference between the display of the video information and the print-out data timing, he does point out that there is a predetermined time lapse from the sending of the print control signal relative to the displaying of the broadcast video signal (col. 9 lines 12-15). In view of this, it would have been obvious to consider this second sending action as that which is extracted by stage 7 as the second time data. Furthermore, it would have been obvious to consider the operation of the transmission section (i.e. the composite controller and extractor stage operating arrangement) as providing the display of the video data and the subsequent printing as prompted by the respective first and second timing signals identified by the extracting section 7.

7. Claim 14 is now rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki in view of any one of Morris et al. (5,862,372), Anderson (4,903,334), Steele et al. (6,049,532) and Greenberger et al. (5,802,382).

It would have been obvious to one of ordinary skill in the art to incorporate a microprocessor in the receiver of Suzuki (Suzuki does not describe his controller 8 beyond a controller) that can execute stored program instructions, to carry out the overall receiving and printing operations, since microcontrollers and microcomputers are very well known devices used in self-operating electronic systems, as recognized by Morris (col. 1 lines 22-27) Anderson (col. 1 lines 29-31), Steele (col. 1 lines 36-36) and Greenberger (col. 1 lines 14-18).

8. Claim 15 is now rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki in view of any one of Morris et al. (5,862,372), Anderson (4,903,334), Steele et al. (6,049,532) and Greenberger et al. (5,802,382), in view of Johnson et al.

It would have been obvious to one of ordinary skill in the art to use the controller of Suzuki the way Johnson uses his microcomputer 60: to detect the end of signal transmission, and to erase the data is from RAM 48 (col. 5 lines 48-56 and col. 10 lines 55-60), at least to not occupy memory capacity when the data is not useful anymore.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor R. Kostak whose telephone number is (571) 272-7348. The examiner can normally be reached on Monday - Friday from 6:30am-3:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David W. Ometz can be reached on (571) 272-7593. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
P.O. Box 1450
Alexandria, Virginia 22313-1450

Or faxed to:

(571) 273-8300

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Customer Service Office whose telephone number is (703) 308-HELP.


Victor R. Kostak
Primary Examiner
Art Unit 2622

VRK